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Application Number 09/965,163
Amended Appeal Brief

Customer No. 30223



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appl. No. : 09/965,163
Applicant : Shridhar P. Joshi
Filed : September 27, 2001
Title : Gaming Machine With Sweepstakes Entry Dispenser

TC/A.U. : 3714
Examiner : Alex P. Rada

Docket No. : 47079-00117USPT

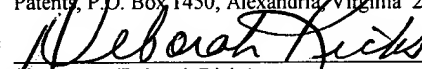
AMENDED APPEAL BRIEF

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Signature (Deborah Ricks)

Dear Commissioner:

This Amended Appeal Brief is submitted pursuant to a notification of Non-Compliant Appeal Brief under 37 C.F.R. §§ 41.37(c)(1)(vi)-(vii) mailed May 16, 2006. The time period for response is one month or thirty days from the mailing date, *i.e.*, by June 16, 2006. This timely Amended Appeal Brief is being filed within the time period required for response, *i.e.*, on June 15, 2006.

The notification of Non-Compliant Appeal Brief noted that the "brief does not contain a concise statement of each ground of rejection presented for review" and that the "brief does not present an argument under a separate heading for each ground of rejection on appeal." The

included explanation provided examples in which the cited references are listed in the same order as listed in the Final Office Action of August 16, 2005. For example, the notification provided the following statements as acceptable concise statements of a ground of rejection:

Claims 1, 14, 18, and 27 were rejected using Moody (US Pub 2002/0093136) in view of Brune *et al.* (US 5,851,148) and Brandstetter *et al.* (US Pub. 2003/0036427). Claims 37 and 38 were rejected using Moody (US Pub. 2002/0093136) in view of Brune *et al.* (US 5,851,148), Brandstetter *et al.* (US Pub. 2003/0036427), and Erlichson *et al.* (US 2001/0039513).

The notification clarifies that the “Arguments must coincide with the grounds of rejections noted in item 5” (*i.e.*, that changes made to the “Grounds of Rejection to be Reviewed on Appeal” section should be reflected in the “Argument” section of the Amended Appeal Brief). The Manual of Patent Examining Procedure (“MPEP”) provides that a statement such as “Whether claims 1 and 2 are unpatentable over Smith in view of Jones . . . would comply with the rule.” MPEP Eighth Edition, Incorporating Revision No. 4, § 1205.02, page 1200-14, right column.

The Applicants submit this Amended Appeal Brief to comply with the notification of Non-Compliant Appeal Brief. This Amended Appeal Brief supersedes the previously filed Appeal Brief.

1. REAL PARTY IN INTEREST

The real party in interest is WMS Gaming Inc., a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 800 South Northpoint Boulevard, Waukegan, Illinois 60085.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

3. STATUS OF CLAIMS

Claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37 and 38 have been finally rejected. Claims 2, 5-13, 15, 17, 19, and 22-26 have been cancelled. Claims 28-36, and 39 have been withdrawn. It is from the final rejection of claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37 and 38 that this appeal is taken.

4. STATUS OF AMENDMENTS

Subsequent to the Final Office Action of August 16, 2005, an Amendment and Reply to Final Office Action was filed on October 14, 2005 in which claims 1, 14, 18, 27, and 37 were amended. In an Advisory Action mailed November 8, 2005, the Examiner advised that the proposed amendments would not be entered because they did not place the application in better form for appeal.

5. SUMMARY OF CLAIMED SUBJECT MATTER

As claimed by independent claim 1, according to some embodiments, the present invention relates to a method of playing a gaming machine. (*E.g.*, page 3, lines 14-15; FIG. 1, reference numeral 10). The method includes receiving a wager (*e.g.*, page 3, lines 23-26) to initiate play of a game (*e.g.*, page 4, lines 4-5) on the gaming machine, and randomly selecting an outcome for the game from a plurality of possible outcomes (*e.g.*, page 4, lines 9-12). A monetary payout is awarded from the gaming machine for a winning outcome. (*E.g.*, page 5, lines 20-22). In response to a predetermined triggering condition, a tangible sweepstakes entry form (*e.g.*, FIG. 3, reference numeral 42) is dispensed from the gaming machine (*e.g.*, page 7, 4-

6). The triggering condition is based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. (*E.g.*, page 7, lines 6-9). The tangible sweepstakes entry form is completed manually with identifying indicia (*e.g.*, page 9, lines 1-2), and submitted to enter the sweepstakes without involving the gaming machine (*e.g.*, page 9, lines 8-11). The sweepstakes is conducted after the sweepstakes entry form is dispensed from the gaming machine. (*E.g.*, page 9, lines 3-6).

As claimed by independent claim 14, according to other embodiments, the present invention relates to a method of playing a gaming machine. (*E.g.*, page 3, lines 14-15; FIG. 1, reference numeral 10). The method includes receiving a wager (*e.g.*, page 3, lines 23-26) to initiate play of a game (*e.g.*, page 4, lines 4-5) on the gaming machine, and randomly selecting an outcome for the game from a plurality of possible outcomes (*e.g.*, page 4, lines 9-12). The selected outcome is represented on a visual display. (*E.g.*, page 4, lines 13-14; FIG. 1, reference numeral 12). A monetary payout is awarded from the gaming machine for a winning outcome. (*E.g.*, page 5, lines 20-22). In response to a predetermined triggering condition, a tangible sweepstakes entry form (*e.g.*, FIG. 3, reference numeral 42) is dispensed from the gaming machine (*e.g.*, page 7, 4-6). The triggering condition is based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. (*E.g.*, page 7, lines 6-9). The tangible sweepstakes entry form is completed manually with identifying indicia (*e.g.*, page 9, lines 1-2), and submitted to enter the sweepstakes without involving the gaming machine (*e.g.*, page 9, lines 8-11). The sweepstakes is conducted after the sweepstakes entry form is dispensed from the gaming machine. (*E.g.*, page 9, lines 3-6).

As claimed by independent claim 18, according to yet other embodiments, the present invention relates to a gaming machine (*e.g.*, page 3, lines 14-15; FIG. 1, reference numeral 10) that includes a credit receiving mechanism (*e.g.*, page 3, lines 23-26; FIG. 1, reference numeral 14) for receiving a wager to initiate play of a game (*e.g.*, page 4, lines 4-5) on the gaming machine. The gaming machine further includes a central processing unit for randomly selecting an outcome for the game from a plurality of possible outcomes. (*E.g.*, page 4, lines 9-12). Means are provided for awarding a monetary payout from the gaming machine for a winning outcome. (*E.g.*, page 5, lines 32-33; page 6, lines 2-3). The gaming machine also includes a dispenser (*e.g.*, FIG. 1, reference numeral 40) for dispensing a tangible sweepstakes entry form in response to a predetermined triggering condition (*e.g.*, page 7, lines 4-6), wherein the triggering condition is based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day (*e.g.*, page 7, lines 6-9). Means are provided for completing the tangible sweepstakes entry form manually with identifying indicia. (*E.g.*, page 9, lines 1-3; FIGs. 1 and 3, reference numeral 42). Means are also provided for submitting the sweepstakes entry form to enter a sweepstakes without involving the gaming machine (*e.g.*, page 9, lines 8-11), wherein the sweepstakes are conducted after the sweepstakes entry form is dispensed from the gaming machine (*e.g.*, page 9, lines 3-6).

As claimed by independent claim 27, according to yet other embodiments, the present invention relates to a method of playing a gaming machine. (*E.g.*, page 3, lines 14-15; FIG. 1, reference numeral 10). The method includes receiving a wager (*e.g.*, page 3, lines 23-26) to initiate play of a game (*e.g.*, page 4, lines 4-5) on the gaming machine, and randomly selecting an outcome for the game from a plurality of possible outcomes (*e.g.*, page 4, lines 9-12) having a plurality of possible winning outcomes (*e.g.*, page 5, lines 20-22 and page 6, lines 27-28). A

monetary payout is awarded from the gaming machine for a winning outcome (*e.g.*, page 5, lines 20-22). In response to a predetermined triggering condition, a tangible sweepstakes entry form (*e.g.*, FIG. 3, reference numeral 42) is dispensed from the gaming machine (*e.g.*, page 7, 4-6). The triggering condition is based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. (*E.g.*, page 7, lines 6-9). The tangible sweepstakes entry form is completed manually with identifying indicia (*e.g.*, page 9, lines 1-2), and submitted to enter the sweepstakes without involving the gaming machine (*e.g.*, page 9, lines 8-11). The sweepstakes is conducted after the sweepstakes entry form is dispensed from the gaming machine. (*E.g.*, page 9, lines 3-6).

As claimed by independent claim 37, according to yet other embodiments, the present invention relates to a method of playing a gaming machine. (*E.g.*, page 3, lines 14-15; FIG. 1, reference numeral 10). The method includes receiving a wager (*e.g.*, page 3, lines 23-26) to initiate play of a game (*e.g.*, page 4, lines 4-5) on the gaming machine, and randomly selecting an outcome for the game from a plurality of possible outcomes (*e.g.*, page 4, lines 9-12) having a plurality of possible winning outcomes (*e.g.*, page 5, lines 20-22 and page 6, lines 27-28). A monetary payout is awarded from the gaming machine for a winning outcome. (*E.g.*, page 5, lines 20-22). In response to a predetermined triggering condition, a tangible sweepstakes entry form (*e.g.*, FIG. 3, reference numeral 42) is dispensed from the gaming machine (*e.g.*, page 7, 4-6). The triggering condition is based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day. (*E.g.*, page 7, lines 6-9). The sweepstakes entry form is completed via a web site on an Internet with identifying indicia on an electronic sweepstakes entry form, and submitted via the web site on the Internet to enter the sweepstakes without involving the gaming machine. (*E.g.*, page 9, lines

8-11). The sweepstakes is conducted after the sweepstakes entry form is dispensed from the gaming machine. (*E.g.*, page 9, lines 3-6).

As claimed by dependent claim 38, according to yet other embodiments, the present invention includes all the method steps described above in reference to independent claim 37 and, further, allowing access to the website by using a security access code. (*E.g.*, page 9, lines 11-14).

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, and 38 were properly rejected under 35 U.S.C. § 103(a) based on a combination of references that includes U.S. Patent No. 5,851,148 (“Brune”), where claims 1, 14, 18, and 27 were rejected over U.S. Patent Publication No. 2002/0093136 (“Moody”) in view of Brune and U.S. Patent Publication No. 2003/0036427 (“Brandstetter”) and claims 37 and 38 were rejected over Moody in view of Brune, Brandstetter, and U.S. Patent Publication No. 2001/0039513 (“Erlichson”).

II. Whether claim 38 was properly rejected under 35 U.S.C. § 103(a) based on a combination of references that includes Erlichson, where claims 37 and 38 were rejected over Moody in view of Brune, Brandstetter, and Erlichson.

7. ARGUMENT

I. The 35 U.S.C. § 103(a) Rejection of Claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, and 38 Over Moody in View of Brune and Further in View of One or More of Brandstetter and Erlichson

Contrary to the Examiner’s allegations, Brune in combination with either Moody, Brandstetter, or Erlichson does not support an obviousness rejection of the pending claims at

least for two reasons: a) the combination of references including Brune fails to teach or suggest all the claim elements of the claimed invention, and b) there is no motivation or suggestion to combine the teachings of Brune with any of the other cited references. Thus, a *prima facie* case of obviousness has not been established.

A. The Combination Of References Including Brune Fails To Teach Or Suggest All The Claim Elements Of The Claimed Invention.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Manual of Patent Examining Procedure (“MPEP”), Eighth Edition, Incorporating Revision No. 4, § 2143.03, page 2100-133, right column (citing to *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *Id.* (citing to *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Independent claims 1, 14, 18, 27, and 37 are directed to “a predetermined triggering condition, said triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day.” Although the Examiner has conceded that this claim element is not disclosed by Moody (and, impliedly, that neither does Brandstetter or Erlichson), the Examiner alleges that the claim element is taught by Brune. As explained below, Brune fails to teach this claim element.

Brune discloses that a “bonus or prize” is awarded “upon reaching [a] goal.” Column 2, lines 55-56. The goal upon which the bonus or prize is awarded is based only on outcomes of the game-play. For example, “prizes may be awarded in response to activating fewer than all indicia in a subset of the display, such as all indicia on one or more rows, columns or diagonals, four corners and the like.” Column 4, lines 53-56. In another example, a “multi-game prize is awarded when all relevant indicia have been unilluminated.” Column 6, lines 20-21. Thus, the

awarding of the bonus or prize of Brune has nothing to do with such criteria as claimed in the current invention.

Although Brune discloses “‘trigger events’ or items, such as the number of games plays, the number of non-winning games, the number of winning cards, and the like,” these trigger events are not related to the awarding of a bonus or prize. Brune, column 2, lines 62-64. The trigger events listed above are only used for determining the bonus amount. For example, Brune discloses that the amount of the bonus or prize is “related to the amount of wagers placed since the last award of a bonus.” Column 2, lines 56-58. Similarly, Brune discloses that the “trigger events” are used to “increase [] the bonus meter.” Column 2, line 61. Brune simply discloses that the value of the award fluctuates according to particular triggering events, like other wagering games. Brune does not teach or suggest anywhere that the bonus is awarded based on any of the disclosed trigger events.

A *prima facie* case obviousness has not been established at least because the combination of references including Brune does not teach or suggest all the elements of the claimed invention. *See Royka*, 490 F.2d 981, 180 U.S.P.Q. 580; *see, also, Wilson*, 424 F.2d at 1385, 165 U.S.P.Q. at 496. At least for these reasons, the Applicant respectfully submits that the independent claims 1, 14, 18, 27, and 37, along with all the dependent claims thereon, are patentable over any combination of references that includes Brune.

B. There Is No Motivation Or Suggestion To Combine Brune With Moody, Brandstetter, or Erlichson

In addition, the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine Brune with Moody, Brandstetter, or Erlichson. Specifically, the Examiner has failed to identify a persuasive suggestion to combine the teachings of Brune with the teachings of Moody, Brandstetter, or Erlichson and instead

improperly used knowledge from applicant's invention to make the combination of Brune with the other cited references.

“[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)). “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *Rouffet*, 149 F.3d at 1355, 47 U.S.P.Q.2d at 1456, (citing *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)). A *prima facie* case of obviousness can *only* be set up where there is “a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998); *see also In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to combine “must be clear and particular.” *Ex parte Maruyama*, 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001), (citing *C.R. Bard, Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)).

To render the claimed invention obvious, the Examiner “must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000), (quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir.

1998)). Obviousness cannot “be established using hindsight or in view of the teachings or suggestions of the invention.” *Ex parte Maguire* (Appendix 9), 2002 WL 1801466, *3 (Bd. Pat. App. & Inter. 2002), (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int’l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)). In other words, the knowledge to combine “*can not* come from the applicant’s invention itself.” *Oetiker*, 977 F.2d at 1447, 24 U.S.P.Q.2d at 1446, emphasis added.

Section 103(a) mandates that the “invention as a whole . . . must be considered in obviousness determinations.” *Wright*, 848 F.2d 1216, 1219, 6 U.S.P.Q.2d 1959, 1961 (Fed. Cir. 1988). The invention as a whole includes the “structure, its properties, and the problem it solves.” *Id.* The determination of obviousness “requires cognizance of the properties of which structure and the problem which it solves, viewed in light of the teachings of the prior art.” *Id.* (citing *In re Rinehart*, 531 F.2d 1048, 1054, 189 U.S.P.Q.2d 143, 149 (C.C.P.A. 1976)). The relevant question in an obviousness determination is “whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working.” *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961-62, (citing *Rinehart*, 531 F.2d at 1054, 189 U.S.P.Q.2d at 149); *see also In re Benno*, 768 F.2d 1340, 1346, 226 U.S.P.Q. 683, 687 (Fed. Cir. 1985).

The independent claims 1, 14, 18, 27, and 37 are directed to “dispensing a tangible sweepstakes entry form” in response to a predetermined triggering condition “based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day from a gaming machine.” Brune does not teach or suggest anything whatsoever about “dispensing a tangible sweepstakes entry form.” At most, Brune teaches that a “bonus or prize . . . is awarded.” Column 2, lines 55-56. In contrast,

Moody discloses a gaming machine that can “print out for the player . . . a sweepstakes ticket” (Abstract), Brandstetter discloses a gaming machine having a dispensing unit that “delivers a slip of paper” such as a raffle ticket (§§ 0011 and 0019), and Erlichson discloses an “automated process of conducting an online sweepstakes and marketing to sweepstakes entrants” (Abstract).

The current invention is directed to dispensing a sweepstakes entry when conducting a wagering game. Field Of The Invention Section, page 2, lines 3-5. Brune is directed to “an incentive for multi-game or multi-hand play by establishing one or more goals, preferably associated with a prize, such that multiple games or hands are required to reach the goals.” Column 1, lines 34-37. Thus, the problems associated with dispensing a sweepstakes entry require a different solution than that encountered in an incentive for multi-game or multi-hand play.

The Examiner has failed to show that a person of ordinary skill, seeking to solve problems related to dispensing sweepstakes entries, would reasonably be expected or motivated to look to incentives for multi-game or multi-hand play. It is, thus, clear that the Examiner has failed to consider applicant’s claimed invention as a whole in combining Brune with the other cited references to reject the pending claims, and that no *prima facie* case of obviousness has been established. See *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961; *Rinehart*, 531 F.2d at 1054, 189 U.S.P.Q.2d at 149; *Benno*, 768 F.2d at 1346, 226 U.S.P.Q. at 687.

At least for the reasons described above, the Applicant respectfully submits that the independent claims 1, 14, 18, 27, and 37, along with all the dependent claims thereon, are patentable over any combination of references that includes Brune.

II. The 35 U.S.C. § 103(a) Rejection Based on Erlichson of Claim 38 Over Moody in View of Brune, Brandstetter, and Erlichson

Claim 38 was rejected on a combination of references that includes Erlichson. Although the Examiner has acknowledged that Moody, which is the primary references, fails to teach the claim element directed to a “security access code,” the Examiner has alleged that Erlichson teaches “allowing access to the website (figures 1-4) as recited in claims 37 and 38.” The Examiner has failed to establish a *prima facie* case of obviousness because the combination of Moody, Brune, Brandstetter, and Erlichson fails to teach or suggest having a “security access code for allowing access to the website.” As noted above, all the claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. *In re Royka*, 490 F.2d 981. “All words in a claim must be considered in judging the patentability of that claim against the prior art”. *In re Wilson*, 424 F.2d at 1385.

Claim 38 is directed to a “security access code” for allowing access to the website. **Nowhere** in the final Office Action is this element of claim 38 -- “security access code” -- mentioned as being disclosed by the cited references. In fact, the element “security access code” is mentioned only when acknowledging that “Moody does not expressly disclose . . . a security access code”

For claim 38, the final Office Action fails to address all the specific elements set forth in the claim. In short, the Applicants were left guessing at what the Examiner’s position may, or may not, be with respect to claim 38. As such, it was impossible for the Examiner to have established a *prima facie* case of obviousness. Therefore, the Examiner has failed to discharge his burden of proof with regard to the obviousness rejection of claim 38.

More importantly, none of the cited references (including Erlichson) teaches having a “security access code” for allowing access to a website. For example, when conducting a full

online text search of Erlichson the only time the term “security” or “secure” is mentioned is in the context of internet communications:

The communication between CCD 100a, CCD 100b and Web server 240 may be secured by any Internet security protocol, such as Secured Sockets Layer ("SSL"). . . .

Erlichson, ¶ 0030. Beyond that, there is no mention of words such as “secure,” “access,” and “code” in relation to accessing a website using a “security access code.”

At least for the reasons described above, the Applicant respectfully submits that the claim 38 is patentable over any combination of references that includes Erlichson.

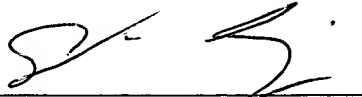
III. Conclusion

Claims 1, 14, 18, 27, and 37 are patentable over any combination of Brune with one or more of Moody, Brune, Brandstetter, and Erlichson at least because Brune (or any of the other references) fails to teach or suggest the claimed triggering conditions. Additionally, claims 1, 14, 18, 27, and 37 are patentable over any combination of Moody, Brune, Brandstetter, and Erlichson at least because a person of ordinary skill, seeking to solve problems related to dispensing sweepstakes entries, would not be reasonably expected or motivated to look to Brune for finding the solution provided by the claimed invention. Further, claim 38 is patentable over any Moody, Brune, Brandstetter, and Erlichson at least because Erlichson (or any of the other references) fails to teach or suggest a “security access code.”

For the reasons set forth above, all of the appealed claims are deemed allowable over the cited references. Applicant respectfully requests that the rejection of the appealed claims be reversed, and that this application be returned to the Examiner with directions to issue a Notice of Allowance.

It is the Applicant's belief that no fees are due at this time. However, the Commissioner is authorized to charge any additional fees inadvertently omitted that may be required (except the issue fee) now or during the pendency of this application to JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447(47079-00117USPT).

Date: June 15, 2006



Sorinel Cimpoes
Reg. No. 48,311
JENKENS & GILCHRIST
225 W. Washington Street, Suite 2600
Chicago, IL 60606
(312) 425-3900 – Telephone
(312) 425-3909 – Facsimile
Attorneys for Appellant

8. APPENDIX OF CLAIMS ON APPEAL

1. A method of playing a gaming machine, comprising:
receiving a wager to initiate play of a game on the gaming machine;
randomly selecting an outcome for the game from a plurality of possible outcomes;
awarding a monetary payout from the gaming machine for a winning outcome;
dispensing a tangible sweepstakes entry form from the gaming machine in response to a
predetermined triggering condition, said triggering condition being based on at
least one of a number of game plays, a frequency of play, a number of activated
pay lines, a player-tracking information, and a time of day;
completing the tangible sweepstakes entry form manually with identifying indicia;
submitting the sweepstakes entry form to enter the sweepstakes without involving the
gaming machine; and
conducting the sweepstakes after the sweepstakes entry form is dispensed from the
gaming machine.
3. The method of claim 1, wherein the selected outcome is a predetermined one or more of
the plurality of possible outcomes, the predetermined one or more of the plurality of possible
outcomes being associated with the monetary payout exceeding a predetermined threshold.
4. The method of claim 1, wherein the selected outcome is a predetermined one or more of
the plurality of possible outcomes, the predetermined one or more of the plurality of possible
outcomes being associated with the monetary payout below a predetermined threshold.
14. A method of playing a gaming machine, comprising:
receiving a wager to initiate play of a game on the gaming machine;
randomly selecting an outcome for the game from a plurality of possible outcomes;
representing the selected outcome on a visual display;
awarding a monetary payout from the gaming machine for a winning outcome;
dispensing a tangible sweepstakes entry form from the gaming machine in response to a
predetermined triggering condition, said triggering condition being based on at

least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day;
completing the tangible sweepstakes entry form manually with identifying indicia;
submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine; and
conducting the sweepstakes after the sweepstakes entry form is dispensed from the gaming machine.

16. The method of claim 14, wherein the selected outcome is a predetermined one or more of the plurality of possible outcomes, the predetermined one or more of the plurality of possible outcomes being associated with the monetary payout exceeding a predetermined threshold.

18. A gaming machine, comprising:

a credit receiving mechanism for receiving a wager to initiate play of a game on the gaming machine;
a central processing unit for randomly selecting an outcome for the game from a plurality of possible outcomes;
means for awarding a monetary payout from the gaming machine for a winning outcome;
a dispenser for dispensing a tangible sweepstakes entry form in response to a predetermined triggering condition, said triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day;
means for completing the tangible sweepstakes entry form manually with identifying indicia; and
means for submitting the sweepstakes entry form to enter a sweepstakes without involving the gaming machine, the sweepstakes being conducted after the sweepstakes entry form is dispensed from the gaming machine.

20. The gaming machine of claim 18, wherein the selected outcome is a predetermined one or more of the plurality of possible outcomes, the predetermined one or more of the plurality of

possible outcomes being associated with the monetary payout exceeding a predetermined threshold.

21. The gaming machine of claim 18, wherein the selected outcome is a predetermined one or more of the plurality of possible outcomes, the predetermined one or more of the plurality of possible outcomes being associated with the monetary payout below a predetermined threshold.

27. A method of playing a gaming machine, comprising:
receiving a wager to initiate play of a game on the gaming machine;
randomly selecting an outcome for the game from a plurality of possible outcomes, the plurality of possible outcomes having a plurality of possible winning outcomes;
awarding a monetary payout from the gaming machine for a winning outcome;
dispensing a tangible sweepstakes entry form from the gaming machine in response to a predetermined triggering condition, said triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day;
completing the tangible sweepstakes entry form manually with identifying indicia;
submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine; and
conducting the sweepstakes after the sweepstakes entry form is dispensed from the gaming machine.

37. A method of playing a gaming machine, comprising:
receiving a wager to initiate play of a game on the gaming machine;
randomly selecting an outcome for the game from a plurality of possible outcomes, the plurality of possible outcomes having a plurality of possible winning outcomes;
awarding a monetary payout from the gaming machine for a winning outcome;
dispensing a sweepstakes entry form from the gaming machine in response to a predetermined triggering condition, said triggering condition being based on at least one of a number of game plays, a frequency of play, a number of activated pay lines, a player-tracking information, and a time of day;

completing the sweepstakes entry form via a web site on an Internet with identifying indicia on an electronic sweepstakes entry form;
submitting the electronic sweepstakes entry form via the web site on the Internet to enter the sweepstakes without involving the gaming machine; and
conducting the sweepstakes after the sweepstakes entry form is dispensed from the gaming machine.

38. The method of claim 37, wherein the web site has a security access code for allowing access to the website.

9. **EVIDENCE APPENDIX**

None.

10. **RELATED PROCEEDINGS APPENDIX**

None.